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APPLICATION NO	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO	CONFIRMATION NO
09 894,655	06 28 2001	Kenny-Tuan T. Dinh	D 99679QD	1634

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EXAMINER

BAREFORD, KATHERINE A

ART UNIT	PAPER NUMBER
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1762

DATE MAILED: 04 02 2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/894,655

Applicant(s)

DINH ET AL.

Examiner

Katherine A. Bareford

Art Unit

1762

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 27 February 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) 28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 13-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

Claims 1-12 are canceled

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 August 2001 is/are a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of Group I, claims 13-27 in Paper No. 6 (Feb. 27, 2003) is acknowledged. The traversal is on the ground(s) that it is believed that these claims are sufficiently related to permit them to be retained in the same application, and an undue burden would not be placed on the Examiner to simultaneously examine and process these claims. This is not found persuasive because as discussed in the Restriction Requirement the inventions of the two groups are distinct. As a result, the Examiner would have to examine each piece of art examined with two different standards of examination of patentability based on the differing scopes of the two inventions. This would place a serious burden on the Examiner.

The requirement is still deemed proper and is therefore made FINAL.

2. Claim 28 is withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 6.

Information Disclosure Statement

3. The file of this application indicates that an Information Disclosure Statement was filed on September 27, 2001. However, no IDS is actually in the present file. If applicant filed an IDS, the Examiner requests that applicant send a copy of that IDS so that it can be properly

examined. If applicant did not file an IDS, the Examiner requests that applicant indicate this, so that the file can be corrected.

Drawings

4. The corrected or substitute drawings were received on August 6, 2001. These drawings are approved.

Specification

5. The abstract of the disclosure is objected to because the abstract should be provided in the form of a single paragraph. Also the invention now being claimed is a method. Correction is required. See MPEP § 608.01(b).

6. The disclosure is objected to because of the following informalities: at page 4, line 22 and page 12, line 28, the serial number of the referred to case needs to be inserted. If the case has not been published as a patent, applicant needs to indicate that the cases are commonly assigned in order to properly incorporate them by reference.

Appropriate correction is required.

Claim Objections

7. Claims 17 and 23 objected to because of the following informalities: (1) in claim 17, line 2, "with drawn" should apparently be "withdrawn" to correspond to the term used in claim 13.

(2) in claim 23, line 4, "methol" should apparently be "methanol" to correspond to the term used in Example 1. Appropriate correction is required.

Claim Rejections - 35 USC § 112

8. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

9. Claims 13-27 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for (see A below), does not reasonably provide enablement for (see B below). The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with these claims.

A) the specification is enabling for a method of coating an outside of a hollow cylinder (50), whereby a hollow shaft (36) coaxial with the cylinder is placed inside of the cylinder and spacing devices (32, 54) are provided on each end of the hollow shaft so as to form liquid tight seal between the top/bottom of the cylinder and the hollow shaft and to prevent liquid from entering the inside of the hollow cylinder (see pages 8-9 of the specification). The joined assembly of the cylinder, hollow shaft and spacing devices are then mounted on a vertical rod (22) which is concentric to and mounted within a cylindrical coating vessel (14) having a top and bottom (see pages 7 and 10 of the specification), such that the vertical rod enters the hollow shaft. Then coating liquid is introduced into the coating vessel adjacent to the bottom to immerse most of the cylinder, and then the coating liquid is withdrawn from the vessel adjacent

the bottom to deposit a layer of coating liquid on the outside of the cylinder (see page 11 of the specification).

B) the specification is not enabled for the method as is presently claimed, because the method as is presently claimed provides for a hollow cylinder to be coated inside of a coating vessel, but as worded, the spacing devices do not have to be connected to the cylinder and furthermore, the claim allows for both the interior and exterior of the cylinder to be coated, which contradicts the teaching of the specification that a seal must be formed by the spacing devices in order to provide for a properly working invention. In fact, the cylinder to be coated could be placed inside of the "hollow shaft" or the cylinder could be mounted on the vertical rod, without the hollow shaft passing over the vertical rod as the claim is worded. As a result, the specification does not teach how to make or use the invention as is claimed.

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. Claims 13-27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 13, line 3, "the first spacing device" and "the second spacing device" both lack antecedent basis.

The other dependent claims do not cure the defects of the claims from which they depend.

Conclusion

12. The Examiner notes the Kaulen (US 3117028) teaches a coating process where ~~the~~ cylinders ~~is~~ to be coated are fixed on spindles (shafts) that pass through the center of the cylinders and introduced into a coating vessel, where at the bottom of the vessel a center hole to hold the spindle is placed (see figure 4). However, Kaulen does not teach or suggest that the spindle is hollow and that when the cylinder is passed into the coating vessel the hollow shaft passes over a vertical rod mounted in the coating vessel.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Katherine A. Bareford whose telephone number is (703) 308-0078. The examiner can normally be reached on M-F(7:00-4:30) with the First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive P. Beck can be reached on (703) 308-2333. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Kath Bareford
KATHERINE A BAREFORD
PRIMARY EXAMINER
GROUP 1100/1700